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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,288	04/25/2003	Thomas E. Barta	00988/1/US (6794-000053/U)	7868
28880	7590	03/14/2005	EXAMINER BERNHARDT, EMILY B	
WARNER-LAMBERT COMPANY 2800 PLYMOUTH RD ANN ARBOR, MI 48105			ART UNIT 1624	PAPER NUMBER

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,288

Applicant(s)

BARTA ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-374 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-374 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1,2,8,10,11,19-22,24,26,41,43-87,89-94 and 374, drawn to compounds, compositions where $Y=N$, classified in class 544, subclasses such as 238,360,364; class 414 subclasses such as 252.02,253.01,254.02 and many other subclasses as determined by the exact nature of substituent thereon.
- II. Claims 1-7,9-42,88 and 377, drawn to compounds and compositions where $Y=C$, classified in class 546, subclasses such as 193,212,etc.; class 514 subclasses 318,326,etc.
- III. Claims 95,96,99-108,111,112,114-116,118,119,121-288,298-300 and 374, drawn to compounds,compositions of formulae (95-1), (104-1), (126-1) where $Y=N$, classified in class 544, subclasses such as 357,374,383; class 515, subclasses 252.11, 254.1,255.03.
- IV. Claims 95-107,109-110,113,115,116,117,120-122,126-130,132,134,137,139-142,144,147,149-152,154-157,159,161,165,167,169,289-306 and 374, drawn to compounds,compositions of formulae (95-1), (104-1), (126-1) where

Y=C, classified in class 546, subclasses such as 233,etc; class 514 subclass 327,etc.

- V. Claims 307-309,311,313-315,317,318,320,322,324,326,328-330,332,333,335,337,339,340, drawn to compounds,compositions of formula (307-1)where Y=N, classified in class 544, subclasses such as 364,374;class 514 subclasses 253.11,255.02.
- VI. Claims 307-312,316-327,329-331,333-336,338-341,346,348,350 and 374, drawn to compounds, compositions of formula (307-1) where Y=C, classified in class 546, subclasses such as 168,201; class 544, subclass 130; class 514, subclasses 235.5, 314, 323.
- VII. Claims 342-345,347,349,351,353,355 and 374, drawn to compounds, compositions of formula (342-1) where Y=N, classified in class 544, subclasses such as 383; class 514 subclass 255.02, etc.
- VIII. Claims 342-347,349,351,352,353,354-359 and 374, drawn to compounds, compositions of formula (342-1) where Y=C, classified in class 546, subclass 212,etc.; class 514 subclass 326,etc.
- IX. Claims 360-366 and 374, drawn to compounds, compositions of formula (360-1) where Y=N, classified in class 544, subclass 374,etc.; class 514 subclass 254.1,etc.

- X. Claims 360-368 and 374, drawn to compounds, compositions of formula (360-1) where $Y=C$, classified in class 546, subclasses such as 207; class 514 subclass 326, etc.
- XI. Claims 369-373, drawn to multiple methods of use employing compounds in Groups I-X, classified in class 514, subclasses various as determined by the exact structure of compounds employed.

In addition to an election of one of the above groups, applicants must further elect one of the following subgroups:

- A. Where A1/A2 are acyclic or form together carbocyclic rings;
- B. Where A1/A2 form together heterocyclic rings.

In addition applicants must also elect a single species within the group/subgroup elected to which claims may be limited should generic claims be found not allowable.

If Group XI is elected applicants must pick a compound group and a single use.

The inventions are distinct, each from the other because of the following reasons:

Compounds within Groups I-X are drawn to a variety of piperazine, piperidine derivatives which are variously classified based on the nature of species which vary considerably from acyclic functional groups to many differing heterocyclic groups as evidenced at the very least by the species particularly embraced in the dependent claims. Such compounds are diversely classified and are not art-recognized equivalents. Art which may anticipate or render obvious one of these groups would not necessarily do the same for those remaining based on the structural dissimilarity of I vs II vs III vs IV, etc. as a whole.

Inventions I-X and XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case more than one use exists for the many compounds being claimed as evidenced by entire classes being claimed.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is

subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Because of its length the restriction is being set forth in writing.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be

accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

To advance the prosecution applicants are requested to correct the dependency of several claims such as 88,346,348-350 which appear to the examiner to recite subject matter outside the claim from which they depend. Thus the examiner has grouped these claims by subject matter recited and not claim dependency.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Art Unit: 1624

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A handwritten signature in cursive script, appearing to read "E Bernhardt".

Emily Bernhardt
Primary Examiner
Art Unit 1624